

REMARKS/ARGUMENTS

The Office Action mailed March 12, 2004 has been carefully considered.

Reconsideration in view of the following remarks is respectfully requested.

Rejection of Claims 1 and 3 Under 35 U.S.C. § 103(a)

Claims 1 and 3 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Staber et al. (U.S. pat. no. 6,137,866; hereinafter, "Staber") in view of legal precedence-rearrangement of parts (MPEP § 2144.04 VI C).

Claim 1 recites, in part, "a shell adapted to physically connect under a telephone." As discussed in the Background section of the specification, this feature is important because a primary market for the invention is in hotel rooms, wherein a guest seeking to connect a laptop computer to the Internet generally would not know where to find the network port in the unfamiliar hotel room, and would instinctually begin his search at the location of the telephone. By adapting the device of the invention for physical connection to the telephone, Applicants provide an intuitive solution to the location of the network port in an unfamiliar environment.

The aforementioned feature is neither disclosed nor suggested by Staber. Specifically, the splitter of Staber is merely electrically connectible to a telephone, but is not adapted for physical connection thereto. Thus it does not provide the intuitive solution of the presently claimed invention.

The Office Action alleges that this feature is well known as taught by legal precedence-rearrangement of parts, and would have been obvious in order to make better use of space.

Applicants respectfully submit that their invention is simply more than a rearrangement. A rearrangement implies the presence of claimed physical components in the prior art, albeit in a different order. This is not the case here. Rather, the invention has the distinct feature of

adaptability to physical connection to a telephone. This adaptability is itself absent from the Staber. It has no counterpart in Staber, and does not constitute simply a rearranged component of Staber.

The position that the claimed feature would have been obvious “in order to make better use of space” is untenable for several reasons. First, it appears to be based on hindsight, unmotivated by any teaching or suggestion in the prior art. Second, it does not accurately characterize the reason for the improvement provided by the invention, which is to offer an intuitive solution to the location of the network port in an unfamiliar environment, rather than to merely conserve space. Finally, even if the issue was preservation of space, such preservation occurs only in the “horizontal” direction, but at the expense of the “vertical” direction since. Specifically, it may preserve desk or table space—that is, in the horizontal direction—but it uses up vertical space since the device is intended to be stacked under the telephone. Whether one is more important than the other is a value judgment which does not advance the preservation of space argument proffered by the Examiner.

Claims 2 – 6 depend from Claim 1, and are patentable over the applied prior art, considered singularly or in combination, at least for the reasons provided above.

Claim 2 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Staber in view of legal precedence-rearrangement of parts, further in view of legal precedence-changes in shape (MPEP §2144.04 IV B).

Claim 2 is directed to the wedge shape of the shell. This structural feature provides the functionality of making the dial pad and display of a conventional telephone more accessible by tilting the telephone in the direction of the user. The Office Action relies on legal precedence articulated in MPEP §2144.04 IV B. However, this legal precedence (*In re Dailey*) recognizes that an exception is made where the claimed arrangement is of significance. As discussed above,

the claimed wedge shape makes the dial pad and display of a conventional telephone more accessible, by tilting the telephone in the direction of the user. This is therefore more than a mere gratuitous shape change, and falls within the exception provided by the *In re Dailey* legal precedence. For this reason at least, Claim 2 is unobvious and defines a patentable invention.

Status of Claims 12 – 15

With respect to Claims 12 – 15, the Office Action states the following:

Regarding claims 12-15 above cited reference and legal precedence discloses the limitation set forth, therefore claims 12-15 and interpreted and thus rejected for the reasons set forth above in the rejection of claims 1-6.

However, Claims 12 – 15 contain limitations that are not present in Claims 1 – 6. The rejection of Claims 1 – 6 therefore necessarily fails to address these other limitations, in contravention of proper examination guidelines.¹

In any case, Claims 12 – 15 all recite “a shell adapted to physically connect under a telephone.” As discussed above, this feature is neither taught nor suggested by the applied prior art, and Claims 12 – 15 are therefore allowable thereover.

Conclusion

It is believed that this Amendment places the above-identified patent application into condition for allowance. Early favorable consideration of this Amendment is earnestly solicited.

¹ “An omnibus rejection of the claim ‘on the references and for the reasons of record’” is stereotyped and usually not informative and should therefore be avoided”; “A plurality of claims should never be grouped together in a common rejection, unless that rejection is equally applicable to all the claims in the group.” MPEP § 707.07(d).

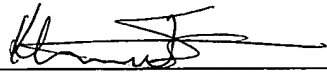
If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the number indicated below.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case. Please charge any additional required fee or credit any overpayment not otherwise paid or credited to our deposit account, No. 50-1698.

Respectfully submitted,

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Dated: June 14, 2004


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